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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
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| 09/770,848      | 01/26/2001  | Arvind D. Patel      | MIDR582--1 (11836.0582 | 8405             |

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EXAMINER

TUCKER, PHILIP C

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 07/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=7

## Office Action Summary

Application No.

770848

Applicant(s)

PATEL

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-24 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1712

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 teaches "further comprising" of the specified oleaginous therein, while parent claim 1 does not teach any specific oleaginous fluid. The scope of the claim is thus not clear.

In claims 4 and 14, the fluid cannot "further comprise" 100% of the oleaginous fluid. Dependent claims fall herewith.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 1712

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 8, 11-13, 17, 18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 137538.

EP '538 teaches an invert emulsion composition comprising the same surfactant as in the present invention, which is used as a drilling fluid (See page 7, lines 1-6, Examples 10, 12 and 13). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

5. Claims 1-18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (5254531).

Mueller teaches an invert emulsion composition comprising an ester oil phase, salted aqueous phase and compounds which are the same as surfactant in the present invention, which is used as a drilling fluid (See examples 2-4, column 6, lines 1-40 and column 10, lines 16-20). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

6. Claims 1-8, 11-13, 17, 18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Voda (3125517).

Art Unit: 1712

Voda teaches an invert emulsion composition comprising the same surfactant as in the present invention, which is used as a drilling fluid (See examples). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

7. Claims 1-6, 8, 11-13, 17, 18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bleeker et al. (4670550).

Bleeker teaches an invert emulsion composition comprising the same surfactant as in the present invention, which is used as a drilling fluid (See Examples 10, 12 and 13). Applicants discovery of the reversible property does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1712


A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 19-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6218342. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of the present invention differ by not being in independent form, the claims of both the present application and the patent teach the same method utilizing the same surfactants, which would render the claims of the present application obvious to one of ordinary skill in the art over the claims of US 6218342.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2597  
July 12, 2002

  
**PHILIP C. TUCKER**  
**ART UNIT 1712**